

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Anthonius A. J. DE GRAAFF et al.

Application No.: 10/607,057

Confirmation No.: 4155

Filed: June 27, 2003

Art Unit: 2625

For: IMAGE SCANNING AND PROCESSING
SYSTEM, METHOD OF SCANNING AND
PROCESSING AN IMAGE AND METHOD
OF SELECTING ONE OF A PLURALITY OF
MASTER FILES COMPRISING DATA
ENCODING A SCANNED IMAGE

Examiner: J. X. Zheng

RESPONSE TO NOTICE OF NON-COMPLAINT APPEAL BRIEF

MS APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Madam:

INTRODUCTORY COMMENTS

In response to the Examiner's Notice of Non-compliant Appeal Brief dated September 30, 2009, Applicants respectfully submit the corrected "STATUS OF THE CLAIMS" and "APPELLANTS' ARGUMENTS" sections of the Appeal Brief, in connection with the above-identified application.

This reply includes

Remarks;

Corrected "STATUS OF THE CLAIMS" Section; and

Corrected "APPELLANTS' ARGUMENTS" Section.

REMARKS

In response to the Examiner's Notice of Non-compliant Appeal Brief, Applicants respectfully submit the corrected "Status of Claims" and "Appellants' Arguments" sections of the Appeal Brief (see attachments). Reconsideration of the Appeal Brief is respectfully requested.

In the event there are any matters remaining in this application, the Examiner is invited to contact Cheng-Kang (Greg) Hsu (Registration No. 61,007) at (703) 205-8000 in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: October 29, 2009

Respectfully submitted,

By 

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Attachments: Corrected "Status of the Claims" Section of the Appeal Brief
Corrected "APPELLANTS' ARGUMENTS" Section of the Appeal Brief

III. STATUS OF THE CLAIMS

Claims 1-18 are currently rejected and appealed, and are set forth in the attached Appendix.

Claims 19-21 in the Amendment of June 5, 2009 are not entered.

VII. APPELLANT'S ARGUMENTS

1. Rejection under 35 U.S.C. § 112, second paragraph

Claims 1-18

The Examiner alleged that the recitation “the controller is further configured to extract data encoding the preview image directly from the stream of data, and to write the extracted data to a thumbnail file in order to create the preview image” as recited in claim 1, “data encoding the preview image is extracted directly from the stream of data, and written to a thumbnail file in order to create the preview image” as recited in claim 6, and “the data encoding the preview image is extracted directly from the stream of data and is written to a thumbnail file in order to create the preview image” as recited in claim 17 are not clear and definite due to the term “directly” as recited in claims 1, 6 and 17. Appellants respectfully submit that the term “directly” simply means that the data encoding the preview image is extracted from the stream of data on the fly (i.e., directly extracted from the stream of data), and is then written as a thumbnail file, thereby creating the preview image. See paragraph [036] of the specification as originally filed. Therefore, it is believed that independent claims 1, 6 and 17 and their dependent claims are clear and definite.

2. Rejection under 35 U.S.C. § 103(a) over Searby in view of Liu

Claims 1, 6 and 17

Independent claim 1 recites a combination of elements including “the controller is further configured to extract data encoding the preview image directly from the stream of data, and to write the extracted data to a thumbnail file in order to create the preview image.”

Independent claim 6 recites a combination of elements including “data encoding the preview image is extracted directly from the stream of data, and written to a thumbnail file in order to create the preview image.”

Independent claim 17 recites a combination of elements including “the data encoding the preview image is extracted directly from the stream of data and is written to a thumbnail file in order to create the preview image.”

Appellants respectfully submit that the above combinations of elements as set forth in independent claims 1, 6 and 17 are not disclosed nor suggested by the references relied on by the Examiner.

As embodied in paragraphs [035]-[036] of the specification as originally filed, the data encoding the original scanned image is passed in a stream from the scanner 1 to the controller 10. The controller then scales down the data of the original scanned image *when the data of the original scanned image arrives at the controller 10* so as to generate a preview image on the fly (see paragraph [036]). The scaled-down data is then sent by the controller 10 to the storage means 13 as a thumbnail file (see paragraph [037]). The data encoding the original scanned image is also sent by the controller 10 to the storage means 13 (see paragraph [038]).

In other words, in the present invention, the extracted data from the data encoding the original scanned image is *not extracted after* the data encoding the original scanned image is stored in the storage means. Instead, the extracted data is extracted *when the data of the original scanned image arrives at the controller*; i.e., the extracted data is directly extracted from the data encoding the original scanned image on the fly. *After* the data is extracted, the extracted data is written to a thumbnail file, thereby *creating the preview image*.

The Examiner has correctly acknowledged that Searby fails to teach extracting data encoding the preview image from the stream of data as recited in claims 1, 6 and 17. Therefore, it is believed that Searby also fails to teach "the controller is further configured to extract data encoding the preview image directly from the stream of data, and to write the extracted data to a thumbnail file in order to create the preview image" as recited in claim 1, "data encoding the preview image is extracted directly from the stream of data, and written to a thumbnail file in order to create the preview image" as recited in claim 6, and "the data encoding the preview image is extracted directly from the stream of data and is written to a thumbnail file in order to create the preview image" as recited in claim 17.

Liu fails to cure the deficiencies of Searby. In particular, Liu describes a method for transforming a digital image including a main image and associated metadata in accordance with a parameter. Liu's method includes checking a compression tag contained in the metadata of the digital image, wherein the digital image is obtained from a file stored in the Exchangeable Image File ("EXIF") format, to determine whether a thumbnail image contained in the metadata of the digital image is in a compressed JPEG format.

However, Liu does not disclose or suggest directly extracting data encoding the preview image from the stream of data on the fly. More specifically, the EXIF stream 220 of Liu contains at least one digital image in the format illustrated in Fig. 2, having a main image 204, simple metadata 206 and complex metadata 208, such as a thumbnail image or audio data. In other words, the thumbnail image in the EXIF stream 220 of Liu *has already been created* when the EXIF stream 220 is formed. Therefore, the thumbnail image in Liu *has been created before it can be extracted from the EXIF stream 220*. Unlike Liu's teaching that the thumbnail image

pre-exists before it can be extracted, the thumbnail file in the claimed invention is *created* by directly extracting the stream of data on the fly. Accordingly, Liu fails to teach "the controller is further configured to extract data encoding the preview image directly from the stream of data, and to write the extracted data to a thumbnail file in order to create the preview image" as recited in claim 1, "data encoding the preview image is extracted directly from the stream of data, and written to a thumbnail file in order to create the preview image" as recited in claim 6, and "the data encoding the preview image is extracted directly from the stream of data and is written to a thumbnail file in order to create the preview image" as recited in claim 17.

Appellants respectfully submit that the present invention is directed towards a scanner generating a stream of data that is processed in *two ways*: one is storing the data in a master file. and the other is extracting from the stream of data preview image encoding data. The preview image encoding data, which is also described as extracted data, is written to a thumbnail file. These features are clearly absent from the utilized references because they at best disclose using a scanner to generate a stream of data that is stored in a master file, from which data is read and used to generate a preview image. This does not have the advantages of the scanner of the present invention of showing the preview image during the scanning of the document.

With regard to the Examiner's reliance on the secondary references, these references have only been relied on for their teachings against some dependent claims. These references also fail to disclose the above combinations of elements and steps as set forth in amended independent claims 1, 6 and 17. Accordingly, these references fail to cure the deficiencies of Searby.

Accordingly, none of the utilized references individually or in combination teach or suggest the limitations of amended independent claims 1, 6 and 17. Therefore, Appellants

respectfully submit that amended independent claims 1, 6 and 17 clearly define over the teachings of the utilized references.

Dependent Claims 2, 7-10 and 15

Claims 2, 7-10 and 15 depend, either directly or indirectly, from independent claims 1 and 6, and are therefore allowable based on their respective dependence from independent claims 1 and 6, which are believed to be allowable.

3. Rejection under 35 U.S.C. § 103(a) over Searby in view of Liu and Patton

Dependent Claims 3, 11 and 18

Claims 3, 11 and 18 depend, either directly or indirectly, from independent claims 1 and 6, and are therefore allowable based on their respective dependence from independent claims 1 and 6, which are believed to be allowable.

4. Rejection under 35 U.S.C. § 103(a) over Searby in view of Liu and Zhou

Dependent Claims 4 and 12-14

Claims 4 and 12-14 depend, either directly or indirectly, from independent claims 1 and 6, and are therefore allowable based on their respective dependence from independent claims 1 and 6, which are believed to be allowable.

5. Rejection under 35 U.S.C. § 103(a) over Searby in view of Liu and Baggs

Dependent Claims 5 and 16

Claims 5 and 16 depend, either directly or indirectly, from independent claims 1 and 6, and are therefore allowable based on their respective dependence from independent claims 1 and 6, which are believed to be allowable.

In view of the above remarks, Appellants respectfully submit that claims 1-18 clearly define the present invention over the references relied on by the Examiner.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.